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| Alex L. Yip Kaye Scholer LLP 425 Park Avenue New York, NY 10022 | | | | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/766,498

Applicant(s)

ELSEY ET AL.

Examiner

MD S. ELAHEE

Art Unit

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Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 March 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 39-54, 56 and 58-60 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 39-54, 56, 58-60 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. This action is responsive to an amendment filed on 03/17/2008. Claims 39-54, 56 and 58-60 are pending. Claim 60 has been added.

Response to Arguments

2. Applicant's arguments mailed on 03/17/2008 Remarks regarding claims 39-45, 56, 59 and 60 have been fully considered but are moot in view of the new ground(s) of rejection which is deemed appropriate to address all of the needs at this time.

Regarding claim 39, the Applicant argues on pages 10-11 that since the examiner admits that Maloney does not teach a third party provider of a product or service and the third party provider being independent of the first service provider, Maloney does not teach receiving, by a first service provider, a call from a caller using a communications device, the call including a current request for a suggestion of a third party provider of a product or service desired by the caller, the third party provider being independent of the first service provider. Examiner respectfully disagrees with this argument. In Col. 9, lines 1-6, Maloney teaches receiving, by a first service provider, a call from a caller using a communication device. In Col. 9, lines 40-44, Maloney further teaches the call including a current request for an item purchase from T.I.C Gourmet Foods Catalog (a suggestion of a provider of a product or service) desired by the caller. The only difference is that Maloney does not teach that the item purchase from T.I.C Gourmet Foods Catalog is a third party provider of a product or service and the third party provider being

independent of the first service provider. In Col. 1, lines 17-27 and Col. 6, line 61- Col. 7, line 6, Rogers teaches this limitation.

The Applicant further argues on pages 11-12 that Rogers does not teach or suggest receiving a call by a “first service provider”, that includes a request for a suggestion of a “third party provider being independent of the first service provider”. Examiner respectfully disagrees with this argument. Examiner depends upon Rogers only for the teaching of a third party provider of a product or service being independent of the first service provider. In Col. 1, lines 17-27, Rogers teaches a call from a technical assistance department of a hardware manufacturer [i.e., first service provider] is transferred to a software manufacturer [i.e., third party provider of a product or service]. It clearly means that Rogers teaches a third party provider of a product or service being independent of the first service provider (see also Col. 6, line 61- Col. 7, line 6).

Thus the rejection of the claim in view of Maloney and Rogers remain.

Claim 59 is rejected for the same reasons as discussed above with respect to claim 39. Furthermore, the Applicant argues on page 13 that Maloney’s identification of the foods product division is not identifying a “geographical region”. Examiner respectfully disagrees with this argument. In page 486 of “Merriam-Webster’s Collegiate Dictionary”, 10th Edition, the definition of “geographical” is “belonging to a particular region”. In other word, the claimed “geographical region” is a particular region. Thus it is clear that the foods product division of

Maloney is the claimed “geographical region” and Maloney’s identification of the foods product division is identifying a “geographical region”.

3. Applicant's arguments filed on 03/17/2008 Remarks regarding claims 46-54 and 58 have been fully considered but they are not persuasive.

Claim 46 is also rejected for the same reasons as discussed above with respect to claim 39.

Claim 45 and 54 are rejected for the same reasons as discussed above with respect to claims 39 and 46 respectively.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. Claims 39-45, 56, 59 and 60 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Maloney et al.** (US 5,555,299) in view of **Rogers et al.** (US 5,617,471) further in view of **Bauer et al.** (US 4,899,375).

As to Claims 39 and 56, with respect to Figures 4-5, **Maloney** teaches a method for use in a telecommunication system, comprising:

receiving, by a first service provider, a call from a caller using a communication device (Col. 9, lines 1-6), the call including a current request for an item purchase from T.I.C Gourmet Foods Catalog [i.e., a suggestion of a provider of a product or service] desired by the caller (Col. 9, lines 40-44);

However, **Maloney** does not teach that the item purchase from T.I.C Gourmet Foods Catalog is a third party provider of a product or service and the third party provider being independent of the first service provider. **Rogers** teaches specific information on a product [i.e., third party provider of a product or service] and the third party provider being independent of the first service provider (Col. 6, line 61- Col. 7, line 6). Having the cited analogous art at the time the invention was made, it would have been obvious to one of ordinary skill in the art to add a third party provider of a product or service and the third party provider being independent of the first service provider to **Maloney's** invention for agent to transparently communicate with customer as taught by **Rogers's** invention in order to provide the customer a specific information of a particular product.

Maloney further teaches retrieving, from storage, data concerning the manner in which one or more prior requests by the caller to the system were handled (Col. 9, lines 15-24);

Maloney further teaches utilizing at least the retrieved data concerning the manner in which one or more prior requests were handled to select a third party to identify a product or service provider in response to the current request (Col. 9, lines 24-35, Col. 10, lines 1-8);

Maloney further teaches searching a database for connection information concerning the selected third party product or service provider (Col. 9, lines 35-45);

Maloney further teaches facilitating a communication between the caller and the selected third party product or service provider based on the connection information (Col. 9, lines 35-45);

Maloney further teaches storing, in the storage, data concerning the manner in which the current request is handled (Col. 9, lines 45-54);

Maloney further teaches after the caller communicates with the selected third party product or service provider, allowing the caller to transfer automatically, in response to a predetermined signal received from the caller's communications device (Col. 9, line 45-54, Col. 10, lines 51-66).

However, **Maloney** in view of **Rogers** does not specifically teach allowing the caller to return to the first service provider without terminating the call.

However, it is obvious that **Maloney** suggests the limitation. This is because **Maloney** teaches transferring a caller from one call center to another call center and determines after each transfer, whether further transfer needs to take place by asking the caller "Is there anything else I can help you with today?" (Figure 5, label 142). This teaching suggests that a caller, after being

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transferred from call center 50 to call center 71 can request transfer back to call center 50 to purchase further items. **Bauer** teaches allowing the caller to return to the first service provider without terminating the call (Col. 6, lines 13-26). Having the cited analogous art at the time the invention was made, it would have been obvious to one of ordinary skill in the art to add return callers to call center 50 after being serviced at call center 71 to **Maloney's** invention in view of **Rogers's** invention as taught by **Bauer's** invention in order to allow a caller to purchase the navy coat or purchase other apparel based on the caller's own choice.

As to Claim 40, **Maloney** teaches the method of claim 39, wherein the one or more prior requests were received in the same call as the current request (Col. 9, lines 30-45 and Col. 10, lines 1-15).

As to Claim 41, **Maloney** teaches the method of claim 39, wherein the connection information including a telephone number (Col. 9, lines 15-18).

As to Claim 42, **Maloney** teaches the method of claim 41, wherein the communication includes telephone connection (Figure 1).

As to claim 43, **Maloney** teaches the method of claim 39, wherein the caller is returned to the first service provider automatically after a disconnection by the identified product or service provider of the communication between the caller and the identified product or service provider (Col. 9, lines 45-52).

As to Claim 44, **Maloney** teaches the method of claim 43, wherein the caller is returned to the first service provider after seconds [i.e., a predetermined period] from the disconnection (Col. 9, lines 65-67).

Claim 59 is rejected for the same reasons as discussed above with respect to claim 39. Furthermore, **Maloney** teaches a method for use in a directory assistance system, comprising:

identifying a foods product division [i.e., geographical region] based on the record (Col. 9, lines 42-45);

transferring the record to call center 71 [i.e., a call center] associated with the foods product division [i.e., geographic region] (Col. 9, lines 55-67);

identifying a third party provider of a product or service that is not associated with call center 50 [i.e., the first service provider] and is located in the geographical region, based at least on the data concerning prior requests contained in the record (Col. 9, lines 55-67).

As to Claim 60, **Maloney** teaches the method of claim 39, wherein the first service provider comprises a directory assistance system (Col. 8, lines 65-67, Col. 9, lines 1-6, 40-44).

7. Claim 45 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Maloney et al.** in view of **Rogers et al.** further in view of **Bauer et al.** further in view of **Marwell et al.** (US 6,404,884).

As to Claim 45, **Maloney** teaches the method of claim 39, wherein the selected third party product or service provider includes purchasing from catalogs;

Maloney in view of **Rogers** further in view of **Bauer** does not teach the following limitation:

“a restaurant”

However, it is obvious that **Maloney** suggests the limitation. This is because **Maloney** teaches order and service placements using CSRs (Col. 1, lines 37-40). **Marwell** teaches CSR placement of restaurant services (Col. 18, line 66 through Col. 19, line 3). Having the cited art at the time the invention was made, it would have been obvious to one of ordinary skill in the art to restaurant reservations to **Maloney's** invention in view of **Rogers's** invention further in view of **Bauer's** invention for additional service offerings as taught by **Marwell's** invention in order to maximize services and responsiveness to customers.

8. Claims 46-53 and 58 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Maloney et al.** (US 5,555,299) in view of **Rogers et al.** (US 5,617,471).

Claims 46 and 58 are rejected for the same reasons as discussed above with respect to claim 39.

Furthermore, **Maloney** teaches a method for use in a directory assistance system, comprising:

assigning software [i.e., an agent in the first service provider], the software [i.e., agent] communicating with the third party product or service provider on behalf of the caller to satisfy the current request (Col. 9, lines 45-54); and

Maloney further teaches storing, in the first service provider, data concerning the current request in association with the caller (Col. 9, lines 23-24).

As to Claim 47, **Maloney** teaches the method of claim 46, further comprising receiving information concerning the caller, and generating a ticket containing details of the desired product or service, wherein select fields of the ticket are populated with the received information (Col. 9, lines 15-25).

As to Claim 48, **Maloney** teaches the method of claim 47, wherein the received information comprises the caller's telephone number (Col. 9, lines 15-17).

As to Claim 49, **Maloney** teaches the method of claim 47, wherein the received information comprises the caller's home address (Col. 9, lines 25-26).

As to Claim 50, **Maloney** teaches the method of claim 47, wherein the received information comprises the caller's present location (Col. 15-19).

As to Claim 51, **Maloney** teaches the method of claim 46, wherein the retrieved data comprises one or more caller preferences (Col. 9, lines 1-5).

As to Claim 52, **Maloney** teaches the method of claim 51, wherein the one or more caller preferences include preferences for selected company divisions [i.e., geographic regions] (Col. 9, lines 1-5).

As to Claim 53, **Maloney** teaches the method of claim 47, further comprising entering the food division [i.e., name of the product or service provider] at which a reservation is desired on the ticket, accessing a database to retrieve other information regarding the product or service provider, and automatically populating selected fields of the ticket with said other information (Col. 9, lines 45-51,55,65).

9. Claim 54 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Maloney et al.** in view of **Rogers et al.** further in view of **Marwell et al.** (US 6,404,884).

As to Claim 54, **Maloney** teaches the method of claim 46, wherein the selected third party product or service provider includes purchasing from catalogs.

Maloney in view of **Rogers** does not teach the following limitation:

“a restaurant”

However, it is obvious that **Maloney** suggests the limitation. This is because **Maloney** teaches order and service placements using CSRs (Col. 1, lines 37-40). **Marwell** teaches CSR placement of restaurant services (Col. 18, line 66 through Col. 19, line 3). Having the cited art at the time the invention was made, it would have been obvious to one of ordinary skill in the art to restaurant reservations to **Maloney's** invention in view of **Rogers's** invention for additional

service offerings as taught by **Marwell**' invention in order to maximize services and responsiveness to customers.

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to MD S. ELAHEE whose telephone number is (571)272-7536. The examiner can normally be reached on Mon to Fri from 9:00am to 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (571) 272-7547. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/MD S ELAHEE/

MD SHAFIUL ALAM ELAHEE

Examiner

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July 15, 2008